

Serial No: 09/469,792

Docket No. 111551 CIP

**REMARKS****Preliminary Matters**

All the claims previously in the application have been canceled and new claims 21-40 have been added. The new claims 21-40 are substantially the same as the claims in the application as originally filed (with the exception of minor variations between original claim 6 and new claim 26 and between original claim 12 and new claim 32).

The reason this is being done arises out of actions taken in this case by the Patent and Trademark Office.

Specifically, in a first Office action in this case mailed 07/13/2004, claims 5, 7, 10, 12 and 19, were indicated to contain allowable subject matter. In an Amendment dated 09/04/2004, applicants chose to cancel all of the other claims then pending in order to facilitate allowance of the application with the claims indicated to contain allowable subject matter, reserving the right to pursue the canceled claims in a continuation.

However, in a subsequent (most recent) Office action dated 09/06/2005, claims 5, 7, 10, 12 and 19 previously indicated to be allowable were rejected based on both previously- and newly-cited art. Applicants believe, however, that at least some of the arguments showing that the rejected claims 5, 7, 10, 12 and 19 are allowable also apply to claims that had been canceled.

Accordingly, applicants desire at this time to pursue on the merits all the originally filed claims. This is something that applicants would have done but for the fact that claims 5, 7, 10, 12 and 19 were first indicated to be allowable and then were rejected. But since canceled claim numbers cannot be re-used, applicants have taken the step of canceling all the claims and re-presenting them as new claims 21-40.

Nonetheless, in order to most easily address the rejections that were set forth in the latest Office action, the following remarks continue to use the old claim numbers 5, 7, 10, 12 and 19 even though those claims are now canceled. It is hoped that this will make it easier for the Examiner to review the remarks herein in light of the grounds of rejection set forth in that Office action. Since original claims 1-20 have been re-

Serial No: 09/469,792

Docket No. 111551 CIP

presented as claims 21-40, it will be understood that the comments made hereinbelow relative to now-canceled claims 5, 7, 10, 12 and 19 also apply to the substantially same new claims 25, 27, 30, 32 and 39.

Arguments are also presented hereinbelow relative to new claims 21-24, 26, 28-29, 31, 33-38 and 40 which are substantially the same as rejected original claims 1-4, 6, 8-9, 11, 13-18 and 20.

#### Claim Rejections

Claims 5, 7, 10, and 19 were rejected under 35 USC 103 as being unpatentable over Albers in view of Murthy in view of Kalmanek. Claim 12 was rejected under 35 USC 103 as being unpatentable over Albers in view of Murthy in view of Elliott.

This rejection is respectfully traversed.

#### Not Obvious To Combine Albers With Murthy

Applicants respectfully traverse the assertion in the Office action that it would have been obvious to a person of ordinary skill to combine Albers with Murthy. Accordingly, it would not have been obvious to combine those two references with Kalmanek or with Elliott.

Albers is directed to a surveillance technique implemented in the public switched telephone network comprised of circuit switches such as the Lucent's 1AESS and 5AESS circuit switches. The examiner's attention is directed, for example, to col. 7, line 30 to col. 8, line 6 in Albers and FIGS. 1 and 5 thereof. When a call is made from Calling Party A to a target subject, the called number is sent to Local Number Portability (LNP) database 120A. As a result of the fact that calls to the target subject are subject to surveillance, the LNP database returns to central office 124 the local routing number (LRN) that has been established for surveillance, illustratively the LRN 301-788-1111. The Called Party Number is thus changed to that particular LRN, which is serviced by CALEA switch 104. Thus the call is routed to CALEA switch 104. The CALEA switch 104, in turn, routes the call to switch 106 servicing the target subject so that the call does ultimately get completed to the called party. However, at the same

Serial No: 09/469,792

Docket No. 111551 CTP

time, a CALEA module within the CALEA switch monitors the incoming call data for this call, e.g., the identity of the caller's phone number, and possibly the call content itself (col. 8, lines 4-6), thereby achieving the desired surveillance.

Looking, then, first, at Albers taken by itself, important differences are apparent between the Albers system and applicants' claimed subject matter. Albers is implemented in the Public Switched Telephone Network, using, for example 5ESS switches, meaning that Albers's network is a circuit-switched, time-division-multiplexed network, not a packet network. See, for example, U.S. Patent 6,873,599 col. 1, lines 28-41 making clear that a 5ESS switch is not a packet switch.

Applicants' claims, by contrast, recite "packets associated with the call." Moreover, applicants' claims recite that the way that the second (e.g., receiving) party and the surveillance receiver both receive/monitor the call is via the mechanism of "multicasting packets." As the examiner is aware, "multicasting" means that separate versions or copies of a signal that originated from a given point arrive at each destination. Albers, by contrast, does not involve any multicasting—let alone the multicasting of packets—as the claims also recite. Rather the call passes serially from the originating local switch to the CALEA switch, which has the monitoring facilities, and from there to the called party.

The Office action recognizes that Albers does not utilize a multicasting technique but cites Murthy for its teaching of multicasting. The Office action asserts that it would be obvious to combine Murthy with Albers. The stated motivation, according to the Office action, is that using multicasting packets "provides lawfully authorized electronic surveillance service in a public switched telephone system."

It is respectfully submitted that that logic is faulty.

Firstly, Albers doesn't need any teachings from Murthy to provide "lawfully authorized electronic surveillance service in a public switched telephone system." Albers already does that. Therefore the Office action's stated motivation for combining teachings from Murthy into Albers is not supportable. Nor has the Office action identified any particular problem or aspect of Albers that would cause the person of ordinary skill to find a need or a motivation to modify the Albers system.

Serial No: 09/469,792

Docket No. 111551 CIP

Moreover, given the fact that Albers is a time-division-multiplexed, circuit-switch system and Murthy is a packet system, it would require a complete transformation of Albers into a packet system in order to introduce in Albers any packet-related technique or circuitry, such as Murthy's bridge. Even if—and it is a big if—this is something the person of ordinary skill would be *able* to do, it is not something the person of ordinary skill would have been *motivated* to do, given that the entire system would have to be changed.

And even if the person of ordinary skill were motivated to re-architect the Albers network into a packet network, there would still be no motivation to implement surveillance using the claimed multicasting approach. Albers's serial call forwarding approach seems to work "just fine" and there is no motivation in the prior art to change it to any kind of multicasting arrangement.

Albers Has No "Gate Controller" and No "Gate Open Message"

Applicants' claim 7 recites that verifying for a call is performed by a "gate controller." Claim 10 also recites a "gate controller" and also recites that the method includes receiving a "gate open message." Claim 12 also recites that the method includes "receiving a gate open message."

These recitations further distinguish the invention from Albers and thus the cited Albers/Murthy combinations.

The Office action points to col. 3, lines 53-57 and col. 7, lines 55-58 of Albers in support of the proposition that Albers anticipates applicants' claim recitation "receiving a gate open message." It thus appears that the Office action is analogizing Albers's SCP with a gate controller and that the Office action is analogizing messages generated by Albers's SCP to a "gate open message."

Thus the Office action seems to be reading "gate open message" as being readable on *any* message and "gate controller" as reading on *any* controller.

This is not justifiable.

Applicants understand that the examiner is allowed to (and should!) give reasonable but broad interpretations to claim terminology. However, it is not proper to read limitations out of a claim. The specific terms of art "gate controller" and "gate

Serial No: 09/469,792

Docket No. 111551 CIP

open message” must be given meaning, import and limiting effect. Whatever message might be transmitted by Albers’s SCP, that message it is not in any sense a “gate open” message. For example, Albers’s messages do not report that anything that can be called a “gate” was “opened.” Moreover, since nothing that Albers’s SCP deals with can reasonably be called a “gate,” Albers’s SCP cannot reasonably be called a “gate” controller.

Moreover, a “gate open message” is a specific term of art relating to a particular operation in a packet network of the type just described. “Gate controller” is similarly a specific term of art. In this technology, a gate is a call-admission control mechanism containing state information about a call being set up in a packet network. (See, e.g., page 16, line 14 et seq. of applicants’ specification.) In the disclosed embodiment for example, such a gate is established using a GATEALLOC message, followed by a GATESETUP message that initializes all the policy and traffic parameters for the gate, and sets the billing information. (See, e.g., p.82, lines 10-11.) Thereafter, the embodiment sends a GATEOPEN (i.e., “gate open”) message from one network edge device to another to notify the other network edge device when a gate for the call has been opened, or set up (p. 25, lines 9-10; p. 90, lines 13-20).

Applicants find nothing in Albers describing such a gate nor any message that is specifically focused on one entity informing another that such a gate has been opened—i.e., the “gate open message” of applicants’ claims.

The above, then, constitute further reasons why claims 7, 10 and 12 are distinguishable from Albers and thus from the cited Albers/Murthy/Kalmanek and Albers/Murthy/Elliott combinations.

#### **Kalmanek Not Citable Against the Claims of this Application**

As noted above, claims 5, 7, 10 and 19 were rejected based on an asserted combination of Albers and Murthy with Kalmanek. However, Kalmanek is not citable against the claims of this application because the inventors of the cited Kalmanek patent are the same as the inventors of this application. Indeed, the cited Kalmanek patent issued out of serial no. 09/366,208 cited at p. 1, line 14 of the present specification. Specifically, since the Kalmanek patent was not granted to “another,” per 35 USC 102,

Serial No: 09/469,792

Docket No. 111551 CIP

it does not qualify as prior art under 35 USC 102(a) or 35 USC 102(e). Moreover, the Kalmanek patent issued after the present application was filed and thus does not qualify as prior art under 35 USC 102(b). Accordingly the Kalmanek patent is not citable as a reference in a "combination" rejection under 35 USC 103.

Moreover, it is submitted that even if there is prior art other than the non-citable Kalmanek patent that would teach the claim limitations that Kalmanek was cited as showing, claims 5, 7, 10 and 19 would nonetheless be allowable for the reasons stated in the previous sections.

#### The Elliott Reference

As noted above, claim 12 was rejected based on an asserted combination of Albers and Murthy with Elliott. Since there is no obvious way to combine Albers with Murthy, as already discussed, there can be no obvious combination of those two references with Elliott

Nor is it clear how such a combination could be made or why the person of ordinary skill would be motivated to make it. It is noted that Elliott is a packet system and, as already noted, Albers is a circuit-switched system. As already discussed, there would be no motivation to completely redesign Albers to be a packet system (if indeed such a thing could possibly be done!!) and so therefore no way to incorporate any quality-of-service (QOS) teachings from Elliott into Albers' SCP messages, as the Office action suggests.

Even if there is some motivation to incorporate some kind of QOS consideration into the network of Albers, claim 12 says a lot more than that. Claim 12 says that a quality of service indicator of the received gate open message is used as the basis for "distinguishing the bearer channel from a data channel." The Office action provides no showing of how any teaching in Elliott combined with the Albers network anticipates this claim language.

Serial No: 09/469,792

Docket No. 111551 CIP

New Claims

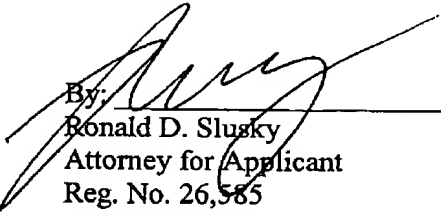
As noted above, the above-argued claims 5, 7, 10, 12 and 19 have actually been canceled but new claims 25, 27, 30, 32 and 39 are substantially the same as the canceled claims and thus the above arguments apply to claims 25, 27, 30, 32 and 39 as well.

New claims 21-24, 26, 28-29, 31, 33-38 and 40 are substantially the same as rejected original claims 1-4, 6, 8-9, 11, 13-18 and 20. Those original claims had been rejected in the first Office action of 07/13/2004 based on the asserted Albers/Murthy combination. Accordingly, the same arguments presented above relative to Albers and Murthy apply with equal force to the new claims 21-24, 26, 28-29, 31, 33-38 and 40.

Reconsideration is requested.

Respectfully,

Charles R. Kalmanek, Jr. et al

By:   
\_\_\_\_\_  
Ronald D. Slusky  
Attorney for Applicant  
Reg. No. 26,585  
(212) 246-4546

Ronald D. Slusky  
Registered Patent Attorney  
353 West 56<sup>th</sup> St.—Suite 5L  
New York, N.Y. 10019-3775  
Date: 12/14/05